



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,272	11/30/2000	Rabindranath Dutta	AUS9-2000-0650-US1	5240
7590	08/09/2004		EXAMINER	
Joseph T. Van Leeuwen P.O. Box 81641 Austin, TX 78708-1641			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 08/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,272

Applicant(s)

DUTTA, RABINDRANATH

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-72 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 37-72 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Status of Claims

1. Claims 37-72 have been examined.

Response to Arguments

2. The Examiner has carefully considered the Applicant's remarks but found them unpersuasive.

Regarding claims 37-72, Pettitt teaches a multi-distribution model for securely distributing content from an Author (provider) to a ***Distributor*** (third party logging server) to a Reseller (merchant) that is adapted to provide digital works to a consumer ('620, figure 2). Although, Pettitt does not specifically use computer networks, it would have been at least obvious to one of ordinary skill to use digital or electronic networks in order to transmit content, encrypt/decrypt content, and verify digital signatures more efficiently. It is important to note, however, that claim 37, does not recite transmitting data over a computer network. Robinson et al. provide a clear teaching for providing evidence of a transaction (e.g. billing statement, receipt) ('022, figure 1-1 and 6a-c) in order to resolve disputes between parties ("any two parties to a real-time transaction"- '022, column 7, lines 32-43) such as a Distributor and Reseller ('022, column 2, lines 1-12) and for storing these evidences by both the service provider party

('022, figures 1-1 and 1-2). The Applicant is of the opinion that a distinguishable feature of the Applicant's claims over the prior art is that it occurs prior to a user obtaining content. In the Pettitt teaching the interaction between the Author (provider), Distributor (third-party) and Reseller (Merchant) also occurs prior to a user obtaining content, for as the Applicant correctly noted the User/Customer initiate the process of decrypting the content after obtaining it from a Reseller (figures 2 and 4; column 3, lines 48-56; column 4, lines 6-15).

Claim 38, refers to an "agreement" between a merchant and a third party logging server. The contents of the registration, as it is claimed, are non-functional descriptive material as they do not affect the implementation of the Applicant's method. Nonetheless, it would have been obvious for two parties to create a contract defining each party's legal responsibility prior to engaging in a commercial transaction ("In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the **reasonable inferences** which one skilled in the art would logically draw therefrom-*In re Shepard*, 138 USPQ 148 (CCPA 1963); a reference is to be considered not for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill of the art -*In re Delisle*, 160USPQ 806 (CCPA 1969)).

In general, the Applicant fails to sufficiently link, for example "product sale request" and a "sales record" with an actual sale, more

specifically, an exchange of funds. Hence, the “product sale request” is just a “request” and a “sales record” is record of the said request. The Examiner applies the same logic to the terms “royalty rate” and “royalty payment”. The claims (see 55 and 58, for example) do not describe a system where a royalty payment is derived from the royalty rate. Hence, a “royalty payment” is just a payment, which is taught by Pettitt, ('620, column 5, lines 28-36).

Regarding “authentication”, Customers, Resellers (merchants) and Distributors (third-party logging server) are all authenticated via registration with a clearinghouse prior to the transmission of the digital works (figure 4; column/line 3/55-4/5). Note, the claims are silent as to what entity performs authentication.

Regarding Official Notices, the MPEP (Section 2144.03) is clear,

an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the examiner’s assertion of official notice would be inadequate.

The Examiner took Official Notice on “plug-ins”. A “plug-in” according to Microsoft Press Computer Dictionary 3rd Edition, is “a small software program that plugs into a larger application to provide additional functionality.” Pettitt teaches notifying a third party logging server when a customer wants to purchase a digital work ('620, figures 2 and 4; column

4, lines 6-43) therefore utilizing a plug-in to enable said functionality would have been obvious to one of ordinary skill. Note, "intended use" terminology such as "adapted to" does not distinguish an apparatus claim from the prior art if the prior art is capable of performing the recited intended use.

Each of the limitations of claim 47 is taught by Pettitt, the Reseller (merchant) transmits content to a customer computer ('620, figures 2 and 4; column 3, lines 48-56; column 4, lines 6-15), the Reseller receives the content from a third-party logging server ('620, figure 2), and a request is sent from the Reseller (merchant) to the Distributor (third-party logging server) in response to a customer requesting purchase ('620, column 4, lines 14). The Examiner would like to point out to the Applicant that the steps as they are claimed are not interrelated such that one follows the other, particularly, the sending of a request. By implying that the content receiving and transmission is necessitated upon the customer purchase request, the Applicant is reading specificity that is not present nor inherent in claim 47 as it is currently written. Recall, it is the responsibility of the Examiner to give claims their broadest reasonable interpretation (*In re Pearson*, 181 USPQ 641 (CCPA 1974)) and limitations from the Specification are not read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)).

Art Unit: 3621

Claim 53 refers to a third party logging server. Claim 49, from which 53 depends, does not, hence, the Examiner understood the server to be the logging module of claim 49.

The following Official Notices are admitted as prior art as they have gone unchallenged or not sufficiently challenged: plug-ins, non-volatile memory, and servers.

The Examiner maintains the rejection.

And yes, the drawings are acceptable.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject-matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 37-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pettitt, U.S. Patent No. 5,864,620 and Robinson et al., U.S. Patent No. 5,915,022.

As per claims 37-72, Pettitt teaches content distribution system comprising:

- obtaining at a third party receiving a plurality of digital works from a plurality of providers, storing the received digital work in a device accessible to the third party, receiving a request from a merchant, transmitting digital works from the third party to the merchant, wherein the merchant is adapted to provide the digital works to a user and recording a sales record corresponding to the product sale (abstract; figure 2; column 1, lines 12-31 and 47-63; column 3, lines 28-35)
- registering a merchant, and a merchant entering into an agreement with the third party (column 4, lines 1-5)
- providing the merchant with an authentication mechanism and authenticating the merchant (figure 4; column 4, lines 6-62)
- a notice to the third party notifying the third party when a user purchases a digital work from a merchant, the notice comprising a digital work and merchant identifier (figure 4; column 4, lines 6-62)
- identifying a royalty rate associated with the digital work, identifying a provider, a royalty rate associated with said provider and transferring funds to a provider (column 4, lines 15-20; column 5, lines 28-36)
- registering a provider with the third party the registering including an agreement regarding the use and payment for using digital works (column/line 3/5-4/5; column 5, lines 38-36)

However, Pettitt doesn't specifically recite implementing his system of a computer network, nor does Pettitt teach recording a sales record at a server. Robinson et al. teach a system for purchasing goods and services of a computer network comprising a merchant server for generating and storing digital sales receipts (figures 1-1, 1-2, 4, and 5; column 3, lines 42-59; column 6, lines 54-67). Regarding billing and royalty statements, Pettitt discloses a third party facilitating the exchange of payment between provider and merchant for services rendered in the sale of a digital work to a user (column 5, lines 29-36). Hence, it would have been obvious to provide each party with a statement detailing the transfer of funds to and from payment accounts. The Examiner takes Official Notice that the existence and functionality of servers, non-volatile memory and plug-ins are well known to those of ordinary skill. Therefore, it would have been obvious to combine the teachings of Pettitt and Robinson et al. in order to more quickly and efficiently provide goods and services to users.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

Art Unit: 3621

or faxed to:

(703) 305-7687 (for formal communications intended for
entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this
application should be directed to the Group receptionist whose telephone
number is (703)
308-1113.

Calvin Loyd Hewitt II

July 28, 2004



JAMES P. FRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600